

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NING0008

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Application Number

09/834,785

Filed

April 13, 2001

First Named Inventor

Hubbard, Edward A.

Art Unit

2457

Examiner

Dalencourt, Yves

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 59,136

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Christopher J. Culberson/

Signature

Christopher J. Culberson

Typed or printed name

509-755-7266

Telephone number

November 22, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No..... 09/834,785
Filing Date..... 4/13/2001
Confirmation No..... 8392
Applicant Niration Network Group, L.L.C.
Inventorship Hubbard
Group Art Unit 2457
Examiner..... Dalencourt, Y.
Attorney Docket No NING0008
Title: Software-Based Network Attached Storage Services Hosted on Massively
Distributed Parallel Computing Networks

PRE-APPEAL BRIEF REQUEST FOR REVIEW

To: Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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The Pre-Appeal Review Panel is respectfully requested to consider the following issues, which are submitted in accordance with the Pre-Appeal Conference Program Rules. Applicant respectfully requests review of the Final Office Action dated 6/24/2010 ("Final Office Action"), Applicant's Response to the Final Office Action, and the Advisory Action dated 9/21/2010. Applicant reserves the right to address additional issues and features of the claims in an appeal.

In the discussion below, Applicant will refer to the following references:

- (1) U.S. Pat. App. Pub. No. 2002/0065864 to Hartsell, et al., filed on June 12, 2001 ("Hartsell");
- (2) U.S. Pat. App. Pub. No. 2002/0133593 to Johnson, et al., filed on March 1, 2001 ("Johnson"), of which Hartsell is a continuation-in-part; and

(3) U.S. Provisional App. No. 60/187,211 to Beale, et al., filed on March 3, 2000 ("Beale"), to which Hartsell and Johnson claim priority.

Claims 29-65 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Hartsell. Applicant respectfully disagrees. As articulated herein and in Applicant's Response to the Final Office Action, the Office has failed to establish a prima facie case of anticipation with respect to claims 29-65 for at least the reason that Applicant's claimed subject matter has a priority date prior to the effective priority date of the subject matter relied on in Hartsell. Withdrawal of the rejections is respectfully requested for at least the reasons presented herein.

To be used in support of a prima facie case of anticipation under 35 U.S.C. § 102(e), the subject matter relied upon in a cited reference must have a priority date that occurs before the earliest priority date of the application under examination. The present application claims priority to several earlier applications dated March 30, 2000. In the Response to Arguments section of the office action, the Office mentions that Hartsell claims priority to several provisional applications, one of which is Beale. Applicant has reviewed the subject matter cited by the Office in the Hartsell reference and submits that this subject matter is not entitled to the March 3, 2000 priority date of Beale for at least the reason that this subject matter is not disclosed in Beale. See, e.g., 35 U.S.C. §119(e). Accordingly, Applicant submits that for at least the aforementioned reason, the subject matter cited by the Office in Hartsell cannot be relied upon in establishing a prima facie case of anticipation with respect to the claims herein. Applicant respectfully requests that the rejections of claims 29-65 under § 102(e) be withdrawn.

1. Independent Claim 29

In making out the rejection of claim 29, the Office argues that its subject matter is anticipated by Hartsell. Applicant respectfully traverses this rejection for at least the following three reasons. First, Hartsell fails to disclose, teach, or suggest all of the

features recited in claim 29 and thus a prima facie case of anticipation cannot be established based on Hartsell.

Second, in its rejection of claim 29 in the Final Office Action, the Office cites to several sections of Hartsell. The sections of Hartsell cited by the Office include Fig. 2 and paragraphs [0189], [0190], [0197], [0204], [0208], [0210], [0236], [0245], and [0246]. As discussed above, however, Applicant has reviewed the subject matter discussed in these sections of Hartsell and submits that this subject matter is not disclosed in Beale and thus is not entitled to the March 3, 2000 priority date of Beale. Thus, this subject matter cannot be utilized in support of a prima facie case of anticipation of claim 29.

Third, in the Advisory Action, the Office states that (sic):

The Examiner respectfully disagrees with Applicant's assertion that the claimed subject matter of this instant application has a priority date prior to the effective priority date of the subject matter relied on in Hartsell. Hartsell claim priority of Continuation-in-part of US application 09/797,200 [Johnson], which claims priority of provisional application 60/187,211. Applicant is kindly suggested to look at paragraphs [0142 - 0143], [0158 - 0159], [0165 - 0166], [0172], [0172], [0179], [0181], [0185], and [0195] of CIP 09/797,200 which correspond to the claimed subject matter of Hartsell (US 2002/0065864). Therefore, based on the priority date of the provisional application (US 60/187,211), which is 03/03/2000, the rejection is proper and sustained by the Examiner. Advisory Action at p. 2.

Thus, in the Advisory Action the Office cites to several sections of Johnson. However, for at least the following reasons, these arguments by the Office still fail to establish a prima facie case of anticipation of claim 29 based on Hartsell.

First, Johnson has a filing date of March 1, 2001, which is after Applicant's priority date of March 30, 2000. Thus, Johnson cannot be relied upon in attempting to establish a prima facie case of anticipation with respect to claim 29.

Second, the subject matter relied on by the Office in Johnson (e.g., paragraphs [0142], [0143], [0158], [0159], [0165], [0166], [0172], [0172], [0179], [0181], [0185],

and [0195]) is not entitled to the priority date of Beale for at least the reason that this subject matter is not disclosed in Beale.

If the Office chooses to continue to rely upon the priority date of Beale in rejecting claim 29, Applicant respectfully requests that the Office cite to specific subject matter in Hartsell and/or Johnson and that the Office explain how this specific subject matter is entitled to the priority date of Beale. For example, Applicant respectfully requests that the Office cite to specific figures and/or paragraphs in Beale that provide support for the subject matter relied upon in its rejections of the claims herein.

2. Dependent Claims 30-41

Claims 30-41 each depend from allowable independent claim 29. Therefore, it is respectfully submitted that the rejection of claims 30-41 is not supported for at least this reason.

3. Claims 42-65

Claims 42-65 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hartsell. In the Final Office Action, the Office simply states that:

Claims 42 - 65 substantially disclose all the limitations of claims 29 - 41 in system and computer-implemented method with minor modification in the claimed language. The reasons for rejecting claims 29 - 41 apply in claims 42 - 65. Therefore, claims 42 - 65 are rejected for the same reasons. Final Office Action at pp. 6-7.

First, inasmuch as this statement by the Office may be interpreted to limit the scope of any of the claims herein, Applicant respectfully disagrees and submits that the Office's reasoning is misguided. Second, Applicant submits that the Office has failed to establish a prima facie case of anticipation with respect to claims 42-65 for at least the reasons that (1) Hartsell fails to disclose, teach, or suggest all of the features recited in claims 42-65 and (2) as discussed above, Applicant's claimed subject matter has a priority date that predates that of the subject matter of Hartsell cited by the Office.

